

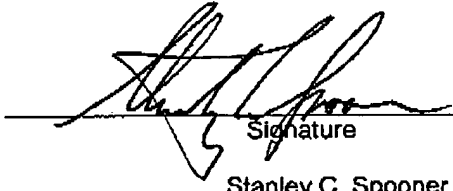
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| PRE-APPEAL BRIEF REQUEST FOR REVIEW  |                   | Docket Number (Optional) |
|--|-------------------|--------------------------|
|  |                   | SCS-540-522              |
| Application Number   | Filed             |                          |
| 10/507,002   | September 8, 2004 |                          |
| First Named Inventor   | BRACEWELL         |                          |
| Art Unit   | Examiner          |                          |
| 2123   | R. Guill          |                          |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p style="text-align: right;"><b>RECEIVED</b><br/><b>CENTRAL FAX CENTER</b><br/><b>MAY 27 2008</b></p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).<br/>Note: No more than five (5) pages may be provided.</p> <p>I am the<br/><input type="checkbox"/> Applicant/Inventor<br/><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)<br/><input checked="" type="checkbox"/> Attorney or agent of record <u>27,393</u><br/>(Reg. No.)<br/><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34.<br/>Registration number if acting under 37 C.F.R. § 1.34 _____</p> <p style="text-align: right;"><br/>Signature<br/>Stanley C. Spooner<br/>_____<br/>Typed or printed name<br/>_____<br/>703-816-4028<br/>Requester's telephone number<br/>_____<br/>May 27, 2008<br/>Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p> |                   |                          |

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**STATEMENT OF ARGUMENTS IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Official Action mailed November 16, 2007 (Paper No. 20071121) and the Advisory Action mailed May 21, 2008 (Paper No. 20080515).

**Error #1. The Examiner's contention that one of Conklin, Hirose and Regli teach the claimed limitation "said directed link is bi-directional to permit a user to traverse the link in either direction" is simply incorrect**

The Court of Appeals for the Federal Circuit has consistently held that "the PTO has the burden under Section 103 to establish a *prima facie* case of obviousness." *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." (emphasis added). *Id.* None of the references teach the claimed "directed link."

In the Final Rejection, the Examiner does not allege that Conklin or Regli teach the claimed "directed link is bi-directional to permit a user to traverse the link in either direction." The best the Examiner can do is to state that Hirose "appears to support bi-directional links." (emphasis added). However, appearing "to support bi-directional links" is not a disclosure of a "bi-directional link," i.e., the claimed element. The test of obviousness is what the reference discloses to one of ordinary skill in the art. The Examiner's failure to identify any teaching of a bi-directional element in Hirose is believed to be an admission that no reference teaches this claimed structure.

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Even in the Advisory Action on page 3 the Examiner does not identify any disclosure of a "directed link." However, the Examiner attempts to gloss over the requirement of a disclosure by now suggesting that "the ordinary artisan would have known that hyperlinks are bi-directional." There is simply no evidence of record in this case establishing or even supporting the Examiner's contention. In fact, as previously pointed out, hyperlinks, as generally known especially in the context of web browsers, are clearly uni-directional links and "teach away" from the claimed "directional link." The Regli reference's use of the word "hyperlinks" connotes only a uni-directional link and does not disclose or even suggest Applicant's claimed bi-directionality of a "directed link" especially one in which the claim defines to "permit a user to traverse the link in either direction."

Absent a disclosure of the claimed "directed link" in at least one prior art reference, the rejection of the independent claims and claims dependent thereon clearly fails for lack of evidence amounting a *prima facie* case of obviousness.

**Error #2. The Examiner fails to provide any rationale for combining bits and pieces of the three cited references and then combining them in the manner of Applicant's independent claims**

In the Final Rejection on page 12, subsections u, v, w, the Examiner alleges a motivation for combining portions of the various references. In its recent decision, the U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (April 2007), held that "[t]o facilitate review [of the reasons for combining prior art], this analysis should be made explicit." *Id.* at 1396. Having pointed out in the previously filed Rule 116 amendment that the Examiner did not meet the Supreme Court requirement of an explicit "analysis" of the motivation to combine, the Examiner, in the Advisory Action, merely concludes that somewhere "the cited references

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would have reasonably suggested the limitation to the ordinary artisan” but without any specifics.

Rather than identify a reference purporting to contain the alleged disclosure or specify where and how the language in that identified reference contains the disclosure, the Examiner increases the level of vagueness from the Final Rejection’s holding that somewhere in the Hirose reference is a suggestion to combine to the Advisory Action’s argument that one of “the cited references would have reasonably suggested the limitation to the ordinary artisan.” This increased level of vagueness even more clearly fails to comply with the KSR requirements.

To protect applicant’s against such unsupported allegations, the Supreme Court in its KSR decision followed the Court of Appeals for the Federal Circuit’s advice that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added, the Supreme Court quoting from the Court of Appeals for the Federal Circuit in *In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006)).

Even in section u of the Final Rejection, where the alleged benefits of the Hirose reference “cost effective, useful and inexpensive design process recorder” is alleged to be the “reason” why one would combine Hirose with Conklin. The Examiner does not realize these benefits have nothing to do with the choice of elements from Hirose and/or being combined with the elements of Conklin. As a result, the Examiner’s statement in section u is merely a conclusory statement reciting generic benefits, i.e., “cost effective,” “useful” and “inexpensive.”

In section v, the Examiner again makes a broad sweeping conclusory statement that “to use the art of Regli with the art of Conklin” which presumably includes anything disclosed in

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Regli and anything disclosed in Conklin, would "provide a great aid to designers" and therefore this is the purported motivation for combining elements. The Examiner simply fails to provide any reason to pick and choose the "directed link" which he alleges is disclosed in Regli with the other elements of the Conklin reference and the Hirose reference in the manner claimed.

The Examiner has simply ignored the KSR decision requirements and instead utilized hindsight reasoning in picking and choosing elements and then merely concluding that it would be obvious to combine them in the manner taught only by Applicant's independent claims. This is not the standard of obviousness under 35 USC §103.

**Error #3. The Examiner does not cite any portion of the Kogan, Nguyen and Weinreich references, which he alleges contains "bi-directional hyperlinks," as teaching the claimed "directed link" as defined in the claims**

Again, while the Examiner alleges that three prior art references teach "bi-directional hyperlinks" (see Final Rejection page 7, section f, ii), the Examiner ignores the language of Applicant's claim, i.e., "said directed link is bi-directional to permit a user to traverse the link in either direction." It is noted that, even assuming there to be a disclosure of "bi-directional hyperlinks" in Kogan, Nguyen and Weinreich, there is no reason for one of ordinary skill in the art to believe that the Regli reference teaches any such "bi-directional" link, whether a hyperlink or the claimed "directed link" in independent claims 1 and 33.

It is the structure recited in Applicant's claims which must be disclosed in at least one prior art reference used in a combination rejection under §103. The Examiner has not indicated how or where Kogan, Nguyen or Weinreich teach Applicant's claimed "directed link" instead of the Examiner's disclosed hyperlink. Instead, the Examiner suggests that Applicant's claim

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language is similar to a hyperlink which is disclosed in Regli and that Regli's hyperlink is somehow similar to bi-directional hyperlinks taught in Kogan, Nguyen and Weinreich and therefore there must be some sort of disclosure in those references which somehow relates to Applicant's claimed invention.

If the Examiner cannot point to where or how a prior art reference teaches a "directed link" which has the claimed attribute of being "bi-directional to permit a user to traverse the link in either direction," there is simply no disclosure of that claimed element. The Examiner has thus far repeatedly failed to identify any such element in the prior art and thus fails to set out a *prima facie* case of obviousness.

#### SUMMARY

In both the Final Rejection and in the Advisory Action, the Examiner continues to refuse to identify where any reference teaches the claimed "directional link." Throughout the outstanding Final Rejection, the Examiner alleges only that the prior art references "appear" to teach claimed features, but appears to teach is not the standard of obviousness. Additionally, the Examiner's inability to provide any explicit analysis as to a rationale for combining any of the prior art references is fatal to the purported *prima facie* case of obviousness.

As a result of the above, there is simply no support for the rejection of Applicants' independent claim 1 and 33 or claims dependent thereon under 35 USC §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.